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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/776,420 | 02/11/2004 | Elvin R. Lukenbach | JBP0508 DIV | 2879 |
| 27777 | 7590 | 12/27/2004 | | EXAMINER |
| PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003 | | | | HARDEE, JOHN R |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1751 | |

DATE MAILED: 12/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|----------------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/776,420 | LUKENBACH ET AL. |
| | Examiner John R. Hardee | Art Unit 1751 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on _____.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1,3,5,8-46 and 49 is/are pending in the application.
 4a) Of the above claim(s) 9, 10, 13-21 and 31-44 is/are withdrawn from consideration.
 5) Claim(s) ____ is/are allowed.
 6) Claim(s) 1,3,5,8,11,12,22-30,45,46 and 49 is/are rejected.
 7) Claim(s) ____ is/are objected to.
 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date 08162004.

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group Ib in the reply filed on November 22, 2004 is acknowledged. The traversal is on the ground(s) that search and examination of the other esters in Group b would not pose an undue burden on the examiner. This is not found persuasive because search and examination of the other esters in the group is not required as long as the elected ester, pentaerythritol tetraoctanoate, is not allowable. Applicant also argues that the examiner has not demonstrated that a serious burden would arise from searching and examining all of the claims. This is not persuasive because search and examination of five separate and distinct inventions is burdensome on its face. The examiner considers the thorough search and examination of one invention to be a burden which is to be taken seriously.

The requirement is still deemed proper and is therefore made FINAL.

Examiner notes that claims 22, 45 and 46 were not withdrawn from consideration. They were searched, examined and addressed in the previous office action. However, the indicated rejection of claim 44 was a typo. The examiner apologizes for any confusion which may have resulted.

Information Disclosure Statement

2. Applicant has submitted at least **80** references for the examiner's consideration in the Information Disclosure Statement filed August 16, 2004. The examiner requests

that applicant provide a list of the 3-5 most pertinent references and their relevance to the presently claimed invention.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 3, 5, 8, 11, 12, 22-30, 45, 46 and 49 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3 and 23-30 of copending Application No. 09/604,449 for the reasons of record in the previous office action.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant's willingness to file a terminal disclaimer is noted with appreciation.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claims 1, 5, 8, 11, 12, 22-27, 29, 30, 46 and 49 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Shah et al., US 4,980,155 for the reasons of record in the previous office action.

Response to Arguments

7. Applicant's arguments filed November 22, 2004 have been fully considered but they are not persuasive. Applicant argues that triethanolammonium stearate, disclosed as a preferred emulsifier by Shah, is not taught to meet the foaming limitations recited by applicant. This is not persuasive because the examiner lacks the facilities to perform foaming tests. Assuming, *arguendo*, that triethanolammonium stearate were not a foaming surfactant, an affidavit to that effect, timely filed by applicant, would have been afforded patentable weight. Attorney arguments cannot take the place of evidence. The examiner notes that the surfactants of claim 45 are not obvious over Shah. As a courtesy to applicant, search and examination of this claim was extended to the other esters recited in the claim.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner, Dr. John R. Hardee, whose telephone number is (571) 272-1318. The examiner can normally be reached on Monday through Friday from 8:00 until 4:30. In the event that the examiner is not available, his supervisor, Dr. Yogendra Gupta, may be reached at (571) 272-1316.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John R. Hardee
Primary Examiner
December 18, 2004